

Serial No.: 10/064,928  
Confirmation No.: 2352  
Applicant: GREGOIRE, Roger J.  
Atty. Ref.: 3006.003.NPUS01

### **REMARKS**

In response to the Office Action dated January 23, 2004, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

The United States Patent and Trademark Office (the "Office") objected to the originally-filed Abstract as containing more than 150 words. The Office also objected to claims 11, 18, and 19 as containing informalities. Claims 1-9 and 11-17 were rejected under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent 5,335,691 to Kolenc. Claims 10 and 18-20 were rejected under 35 U.S.C. §103 (a) as being unpatentable over *Kolenc* in view of U.S. Patent 4,171,492 to Bass. The Applicant shows, however, that the pending claims are patentably distinguishable over the cited prior art, and the Applicant thus respectfully submits that the pending claims are ready for allowance.

### **Information Disclosure Statement**

The Office indicates that "the listing of references in the specification in not a proper information disclosure statement." Applicant hereby asserts that a proper IDS was electronically filed (eIDS) on 29 August 2002 as required by 37 C.F.R. 1.98(b). To serve as evidence of such filing, please see the attached eIDS as filed on 08/29/2002 and the Acknowledgement Receipt generated by the USPTO which confirms receipt of such eIDS. Applicant therefore requests that Examiner please consider the items listed thereon.

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### **Objection to the Abstract**

The Office objected to the Abstract for exceeding 150 words. The Applicant has herein amended the Abstract to not exceed 150 words. Examiner Bastianelli is thanked for the keen eye.

### **Objection to Claim 11, 18, & 20**

The Office objected to claims 11, 18, and 19 as containing informalities. Claim 11 has been amended to correct an antecedent error. Claims 18 & 19 have been amended to correct claim terminology. The Applicant, however, believes claim 20 is correct as originally presented. Examiner Bastianelli is again thanked for the keen eye.

### **Rejection Under § 102 (b)**

Claims 1-9 and 11-17 were rejected under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent 5,335,691 to Kolenc. In response, the Applicant requests that the Examiner reconsider and withdraw the rejection in view of the following remarks.

A claim is anticipated only if “each and every element” of the claimed invention is found either expressly or inherently described in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. (BNA) 81, 84 (Fed. Cir. 1986) (“absence from the reference of any claimed element negates anticipation.”); *In re Schreiber*, 128 F.3d 1473, 1477, 44 U.S.P.Q.2d (BNA) 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d (BNA) 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the

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patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *See ATD Crop. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q. 2d (BNA) 1321, 1328 (Fed. Cir. 1998). *See also In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q. 2d (BNA) 1655, 1657 (Fed. Cir. 1990). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”). As the Applicant shows, however, independent claims 1 and 11, and thus the dependent claims thereunder, are patentably distinguishable over *Kolenc*. The reference to *Kolenc* does not anticipate this invention, so the Applicant respectfully requests that Examiner Bastianelli remove the 35 U.S.C. § 102 (b) rejection of claims 1-9 and 11-17.

#### **1. *Kolenc* Does NOT Anticipate Claims 1-10**

*Kolenc* does not anticipate independent claim 1. Claim 1 requires “wherein the diaphragm cap and the diaphragm plate are *fixedly joined together* with the one or more diaphragms disposed there between, providing a singular assembly for disposal within the diaphragm valve” (emphasis added). *Kolenc*, in contradistinction to this invention, has a “valve ring” that inserts into, and is clamped within, a valve body. The “valve ring” of *Kolenc* is NOT “*fixedly joined together*” with the “valve body.” As *Kolenc* explains, the “seat assembly includes a resilient annular seat ring *positioned in the chamber*” (U.S. Patent 5,335,691 to *Kolenc* at column 2, lines 4-6) (emphasis added). A “bonnet member” slides into and within an interior chamber of the valve body, and a “bonnet nut” threads onto the valve body (*Kolenc* at column 5, lines 36-49). When the bonnet nut is tightened, forces are applied to compress the valve ring, the diaphragm, and a seat ring “into sealing engagement with the bottom wall of the chamber” (*Id.* at column 6, lines 34-38). Because the bonnet nut can be removed, *Kolenc*’s valve may be disassembled for repair of the diaphragm. As FIGS. 2 and 4-5 also illustrate, *Kolenc* does NOT “*fixedly [join] together*” the valve ring with the valve body. The reference to *Kolenc*,

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then, does not anticipate this invention, so the Applicant respectfully requests that Examiner Bastianelli remove the 35 U.S.C. § 102 (b) rejection of independent claim 1.

The dependent claims are also not anticipated. Because *Kolenc* does not anticipate independent claim 1, the dependent claims 2-10 are likewise unanticipated. The Applicant, then, respectfully asks Examiner Bastianelli to remove the 35 U.S.C. § 102 (b) rejection of claims 1-10.

## **2. *Kolenc* Does NOT Anticipate Claims 11-20**

*Kolenc* also does not anticipate independent claim 11. Claim 11 requires “a singular diaphragm assembly having the at least one diaphragm disposed therein and a valve seat for engaging with the at least one diaphragm” (emphasis added). *Kolenc*, in contradistinction to this invention, has separate diaphragm components that must be inserted and clamped within the valve body. As *Kolenc* again explains, an annular seat, a seat member, a sleeve, and the diaphragm(s) all insert into the valve chamber (shown, respectively, as reference numerals 50, 42, 56, and 18 in FIGS. 1 & 3-4 of *Kolenc*). As this response explains above, a “bonnet member” then slides into and within the valve chamber of the valve body, and a “bonnet nut” clamps the components “into sealing engagement with the bottom wall of the chamber” (*Kolenc* at column 6, lines 34-38). *Kolenc* does NOT teach “a singular diaphragm assembly” within the valve body. *Kolenc*, then, does not anticipate this invention, so the Applicant respectfully requests that Examiner Bastianelli remove the 35 U.S.C. § 102 (b) rejection of independent claim 11.

The dependent claims are also not anticipated. Because *Kolenc* does not anticipate independent claim 11, the dependent claims 12-20 are likewise unanticipated. The Applicant, then, respectfully asks Examiner Bastianelli to remove the 35 U.S.C. § 102 (b) rejection of claims 11-20.

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For the above reasons the Applicant submits that nowhere in the *Kolenc* reference is there believed to be any disclosure or suggestion to modify the structure shown in a manner to achieve the claimed invention. In view of the above, the Applicant requests the reconsideration and withdrawal of the rejection of claims 1-9 and 11-17 under 35 U.S.C. § 102 (b). The Applicant also asks that the Examiner indicate the allowance of the claims in the next paper from the Office.

**Rejection Under 35 U.S.C. § 103 (a)**

Claims 10 and 18-20 were rejected under 35 U.S.C. §103 (a) as being unpatentable over *Kolenc* in view of U.S. Patent 4,171,492 to Bass. The Applicant respectfully requests that the Examiner reconsider and withdraw the above rejection of the claims in view of the following remarks.

A determination under 35 U.S.C. § 103 (a) is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d (BNA) 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ (BNA) 459, 467 (1966), *see also Robotic Vision Sys., Inc. v. View Eng'g Inc.*, 189 F.3d 1370, 1376, 51 USPQ (BNA) 2d 1948, 1953 (Fed. Cir. 1999).

In line with this standard, case law provides that “the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.” *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ 2d

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(BNA) 1529, 1531 (Fed. Cir. 1988). The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d (BNA) 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d (BNA) 1614, 1617. The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *See In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d (BNA) 1673, 1681 (Fed. Cir. 1988); *see also In re Longi*, 759 F.2d 887, 897, 225 USPQ (BNA) 645, 651-52 (Fed. Cir. 1985). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d (BNA) 1780, 1783-84 (Fed. Cir. 1992).

The examiner has the burden of establishing a *prima facie* case of obviousness. *See In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d (BNA) 1210, 1214 (Fed. Cir. 1995). The burden to rebut a rejection of obviousness does not arise until a *prima facie* case has been established. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ 2d (BNA) 1955, 1957 (Fed. Cir. 1993). Only if the burden of establishing a *prima facie* case is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant. *See In re Deuel*, 51 F.3d 1552, 1553, 34 USPQ 2d (BNA) 1210, 1214 (Fed. Cir. 1995), *see also Ex parte Obukowicz*, 27 USPQ 2d (BNA) 1063, 1065 (B.P.A.I. 1992).

With the above legal guidelines reviewed, the Examiner should now appreciate the nonobviousness of this invention. Claims 10 and 18-20 are not obvious over *Kolenc* in view of *Bass*. Claims 10 and 18-20 depend from independent claims 1 and 11, respectively. Claim 10 thus incorporates the same patentable features of independent claim 1. Claim 18-20 incorporate the same patentable features of independent claim 11. The combination of *Kolenc* and *Bass* still

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fails to teach "*fixedly [joining] together*" the valve ring with the valve body, as independent claim 1 requires. The combination of *Kolenc* and *Bass* also fails to teach "*a singular diaphragm assembly*," as independent claim 11 requires. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Kolenc* and *Bass* to obviate this invention. Because the combination of *Kolenc* and *Bass* does not teach or suggest all the claim limitations, the Applicant respectfully submits that the requirement and burden of presenting a *prima facie* case of obviousness under 35 USC § 103 (a) has not been presented. Therefore the Applicant requests the reconsideration and withdrawal of the rejection claims 10 and 18-20 under 35 USC § 103 (a).

Given the above, Applicant requests that the rejection of claims 10 and 18-20 under 35 U.S.C. § 103 (a) be reconsidered and withdrawn and that the Examiner indicate the allowance of the claims in the next paper from the Office.

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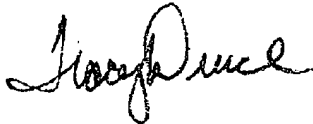
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The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, Order No. 3006.003.NPUS01.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,



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